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Paper No. 18
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Networks Associates Technology, Inc.

Serial No. 75/218,102

John L. Slafsky of Wilson Sonsini Goodrich & Rosati for
Networks Associates Technology, Inc.

Angela M. Micheli, Trademark Examining Attorney, Law Office
108 (David E. Shallant, Managing Attorney).

Before Cissel, Hairston and Rogers, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On December 17, 1996, the above-referenced application
was filed to register the mark "REMOTE DESKTOP" on the
Principal Register for a "computer program which provides
remote viewing, remote control, communications and software
agent distribution within personal computer systems and
across computer network systems," in Class 9. The
application was based on applicant's claim of first use of

the mark on November 15, 1994, and use in interstate commerce since January 15, 1995.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act on the ground that the term applicant seeks to register is merely descriptive of the goods identified in the application. Noting that "[r]emote control software allows the user to have control over another computer that may not be nearby," and that "a desktop is an image on the screen of the computer that resembles a desktop," she concluded that the term sought to be registered "merely describes a feature of the goods." She stated that "[t]he term is used in the computer industry to refer to using a computer by remote control."

Included with the refusal to register were photocopies from a glossary of computer terminology wherein the word "desktop" is defined as "an on-screen representation of a desktop. The windowing capabilities built into graphical user interfaces (GUIs) provide a 'virtual desktop,' in which the user views an infinite desktop full of documents. Both the Macintosh and Windows use this metaphor, but the Mac more closely simulates a real desktop." The term "remote control software" is defined as "software, installed in both machines, that allows a user at a local computer to have control of a remote computer

via modem. Both users run the remote computer and see the same screen. Remote control operation is used to take control of the unattended desktop personal computer from a remote location as well as to provide instruction and technical support to remote users."

Also submitted in support of the refusal to register were excerpts retrieved from the Nexis® database of periodical publications wherein the term "remote desktop" appears in the text of a variety of articles. The first article discusses applicant's software in connection with the earnings of applicant's predecessor. The article states that the business wrote off several million dollars "from in-process research and development related to the acquisition of the remote desktop product line."

Other examples of the use of the term "remote desktop[s]" shown in these excerpts are as follows:

... in the upcoming Novell application launcher, which lets network users launch applications onto remote desktops.

... Unicenter TNG, which enables clients to monitor and administer IT resources in a consistent manner from all types of local and remote desktops, including Solaris workstations and NCs.

MIS Desktop management on the Net PC is provided by Intel's LANDesk Client Manager (LDCM) 3.1, for remote desktop management and hardware/software asset inventory.

The client contains minimal information for booting the remote desktop, establishing a server connection and providing a user interface.

Entire security appliances can be configured and managed from one local or remote desktop.

... a ProShare Conferencing Video System 200 video card, camera, microphone and coder/decoder software that connects the remote desktop and instructor via an ISDN line.

and

Wind communications software or modems were included, we tested how easy it was to send and receive the-mail, hook up to remote desktops, and connect to the Web.

Applicant responded to the refusal to register by arguing that "REMOTE DESKTOP" is not merely descriptive of the goods set forth in the application because it does not describe any particular feature or characteristic of applicant's software. Applicant argued that the evidence submitted by the Examining Attorney does not support the refusal of registration because it shows "REMOTE DESKTOP" either in reference to applicant's own software or in connection with accessing remote computers, but not as a descriptive term for software which allows remote access to computers.

The Examining Attorney was not persuaded by applicant's arguments, and in the second Office Action, she made final the refusal to register under Section 2(e)(1) of

the Act. Attached to the final refusal to register were copies of additional computer dictionary definitions and more excerpts retrieved from the Nexis® database. The word "remote" is defined as meaning "not in the immediate vicinity, as a computer or other device located in another place (room, building, or city) and accessible through some type of cable or communications link." The term "desktop" is defined as meaning "an on-screen work area that uses icons and menus to simulate the top of a desk. The desktop is characteristic of the Apple Macintosh and of windowing programs such as Microsoft Windows."

Examples of the excerpts from the database of publications are as follows:

Digital's ClientWorks remote desktop management interface software also is present. Among other things, it tracks inventory and provides enough information for upgrade...

Integrated Local and Remote Desktop Client Manageability-Reduces the total cost of PC ownership through local and remote network systems management...

... which offers the prospect of software tools that may solve the kind of remote desktop management problems that Java NCs are designed to attack...

...users no longer need to start an entire remote desktop in order to run multiple remote applications within the same session.

...ZENworks will allow policy-based software distribution and facilitate remote desktop management and maintenance.

... gives a complete end-to-end review which cuts across the entire Intranet, from centralized servers to local and remote desktops.

and

Hallmark is installing Microsoft Corporation's Systems Management Server for remote desktop management.

Still other examples include use of the term in connection with "handling remote desktop control"; "gaining control of a remote desktop"; providing "remote desktop configuration and management"; "the remote desktop protocol"; "using remote desktop access to cut support costs"; "the latest in remote desktop management functionality"; "remote-desktop connections"; tracking "remote desktop control"; and setting preferences "from a remote desktop."

The applicant responded to the final refusal to register the mark under Section 2(e)(1) of the Act by amending the application to seek registration on the Supplemental Register.

The Examining Attorney responded to this amendment by refusing registration on the Supplemental Register under Section 23 of the Lanham Act on the ground that the term is incapable of identifying applicant's goods and distinguishing them from those of others. She held that "REMOTE DESKTOP" is a generic term, the apt or common

descriptive name for applicant's products, and as such, is prohibited from registration on the Supplemental Register.

Applicant responded with argument that the term it seeks to register is not generic for the computer software on which applicant uses the term as a trademark. Applicant argued that its mark is capable of distinguishing its goods and that the Examining Attorney had not met her burden of demonstrating that the mark is generic. Attached as exhibits to applicant's response were the results of a computer search of on-line dictionaries, including forty-three dictionaries devoted to computer-related terms and phrases, showing no listing for the term "remote desktop." Also submitted as an exhibit to applicant's response was a printout from a private database of trademark registration information. The printout indicates that sixteen federal trademark registrations for computer software products include the word "desktop" without a disclaimer of that term, and that thirty-two computer software product trademarks which include the word "remote" have been registered without a disclaimer of that word. Applicant argued that just because its mark consists of two generally recognized words used in the computer field does not mean that the mark in its entirety should be considered to be incapable of identifying applicant's goods and

distinguishing them from similar products which emanate from other sources.

The Examining Attorney was not persuaded by applicant's evidence or arguments. In her fourth Office Action, she made final the refusal to register on the Supplemental Register. Attached to this final refusal were copies of the text from the specimen submitted by applicant with the application as filed and copies of six pages apparently from various Internet sites, wherein the term "remote desktop" appears in connection with information about computers. The term appears as part of phrases such as "remote desktop configuration," "remote desktop managers," "remote desktop protocol," and, under the heading of "REMOTE MANAGEMENT," a specific reference to applicant's software is made by using the mark sought to be registered.

Applicant timely filed a Notice of Appeal. Both applicant and the Examining Attorney filed briefs on appeal, but applicant did not request an oral hearing before the Board.

The sole issue before us in this appeal is whether the term applicant seeks to register, "REMOTE DESKTOP," is generic in connection with the product specified in the application, a "computer program which provides remote

viewing, remote control, communications and software agent distribution within personal computer systems and across computer network systems." While we find this to be a close case, after careful consideration of the evidence and arguments of record in this appeal, we find that the Examining Attorney has not met her substantial burden in establishing that this mark is unregistrable on the Supplemental Register because it is incapable of identifying and distinguishing applicant's goods.

As the applicant points out, the Examining Attorney bears a significant burden when refusing registration on the ground that a mark is generic. She is required to produce a "substantial showing" based on "clear evidence of generic use" in order to establish that the term in question is unregistrable on the Supplemental Register. In *re* Merrill Lynch, Pierce, Fenner, and Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143, (Fed. Cir. 1987). Any doubt as to whether the term is capable of identifying and distinguishing the products of an applicant must be resolved in favor of the applicant. In *re* Grand Metropolitan Foodservice, Inc. 30 USPQ2d 1974 (TTAB 1994).

Although the Examining Attorney cited the proper test for genericness as the one laid out by the Court of Appeals for the Federal Circuit in *H. Marvin Ginn Corp. v.*

International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986), the evidence of record in this appeal does not support her contention that the elements of this test for genericness have been met.

The test is well known. First we must determine the genus of goods or services in connection with which the mark is used. *Id.* At 530. The second part of a test is to resolve whether the term sought to be registered is understood by the relevant public as referring primarily to that genus of the goods or services. *Id.* It is the Examining Attorney's responsibility to provide evidence which demonstrates that the principal significance of the term is as an indication of the nature or class of the particular product. *Feathercombs, Inc. v. Solo Products Corp.*, 306 F.2d 251, 134 USPQ 209 (2d Cir. 1962).

Instead of identifying the genus of goods that the mark is used for, i.e., remote control software, the Examining Attorney simply recites the goods as they are identified in the application. Then she contends that the mark is recognized by people who purchase computers as a generic term for the goods, but the evidence of record fails to establish that the term applicant seeks to register is used or understood by anyone in the field of computers as the generic name for software of the type

specified in the application, i.e., remote control software. It is clear from the evidence of record that "remote desktop" can be used to refer to a computer which is not physically near another computer or to the on-screen display of a remote computer, but this record does not contain evidence which establishes that "REMOTE DESKTOP" is used generically in reference to applicant's software. "Remote access software" and "remote control software" would appear to be generic terms for this kind of computer program, but the Examining Attorney has not shown that the "REMOTE DESKTOP" is used, or is needed to be used, by anyone as a name for the kind of software that allows remote access to a computer.

In summary, although the mark sought to be registered undoubtedly highly descriptive of the goods specified in the application within the meaning of Section 2(e)(1) of the Lanham Act, our doubts regarding whether the evidence of record establishes that this term is generic for this kind of software must be resolved in favor of the applicant. Accordingly, registration on the Supplemental Register is justified.¹

¹ On a different record, in an inter partes context, we might reach a different conclusion.

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Decision: The refusal to register on the Supplemental Register is reversed.

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